

## REMARKS

Applicant would like to thank The Board for the Decision rendered on September 15, 2010. While Applicant acknowledges and appreciates the Board's decision, Applicant respectfully does not necessarily agree with the Board's findings and conclusions. However, in order to further prosecution of the instant application, Applicant files the RCE submitted herewith and respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1, 3-12, 20.

The following claims are *independent*: 1, 20.

The following claims have previously been *cancelled* without prejudice or disclaimer: 2, 13-19.

Please *add new* claim 20 and please *amend* claims 3-5, 7-10; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

### Claim Rejections – Double Patenting

The Office Action has provisionally rejected claims 1 and 3-12 of this application on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of co-pending application 10/730,224, now US Patent No. 7,529,702. Although Applicant does not necessarily agree with the relative characterization of the claims of this and the cited co-pending application, the Applicant is prepared to file any necessary terminal disclaimer should the Examiner maintain the rejection.

### Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-9 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Maltzman, US Publication No. 2002/0107779 (hereinafter “Maltzman”), in view of Moshal, et al., US Publication No. 2001/0042041 (hereinafter “Moshal”), in further view of Sloan, et al., US Publication No. 2005/0091140 (hereinafter “Sloan”), in further view of Sheehan, et al., US Publication No. 2001/0049647 (hereinafter “Sheehan”), in further view of Buist, et al., US Publication No. 2002/0035534 (hereinafter “Buist”), in further view of Ausubel, et al., US Publication No. 2004/0054551 (hereinafter “Ausubel”), in further view of Agarwal, et al., US Publication No. 2002/0099646 (hereinafter “Agarwal”), in further view of Hoffman, et al., US Publication No. 2002/0049664 (hereinafter “Hoffman”), and in further view of Official Notice.

### Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or

nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*<sup>1</sup>, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, the Examiner has failed

<sup>1</sup> The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

to fulfill MPEP § 706.02(j) requirements **(C)** and/or **(D)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Applicant respectfully submits that the rejection of pending claims 1 and 3-12, in particular of independent claim 1, is not well founded as will be explained and should be withdrawn, and the rejected claims allowed.

With reference to rejected independent claim 1, such claim has 5 elements. While Applicant does not necessarily agree with the teachings attributed to the references used in forming the pending 103 rejection, Applicant notes that the Examiner has based the rejection upon the primary reference of Maltzman, and has, in 3 instances, admitted specific elements were not disclosed by Maltzman. (See Office Action, at pages 6-8.) In those instances, the Examiner was compelled to point to **3** different references- Moshal, Sloan and Sheehan - to each provide **ONE** of the **3** teachings admittedly missing from the primary reference Maltzman. Accordingly, the rejection of claim 1, is formed, for a claim having only 5 elements, by a combination of **4 different** prior art references with no clear motivation to combine these references and teachings expressed in the prior art itself. The situation is compounded with respect to the dependent claims, for which the Examiner must bring in 4 additional references to form their respective rejections. This appears to be a case of using Applicant's claims as a roadmap to reconstruct the prior art to form the various rejections, which has long been established as being improper. As indicated above, in order to be rejected under 35 USC §103, Applicant's claimed invention must necessarily be in the prior art at the time of the invention. Applicant respectfully submits such has not been established by the Examiner.

Applicant also presents new claim 20 for examination on the merits to alternatively claim Applicant's invention. Applicant respectfully submits such claim is not suggested or taught, and therefore not rendered obvious in view of, nor anticipated by, the prior art of record. Applicant submits such claim is patentably distinct from the prior art and is thus allowable, which action is earnestly solicited.

## CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-

assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1, 3-12, 20, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

### Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-354. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-354.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
*Attorney(s) for Applicant,*  
CHADBOURNE & PARKE LLP

Dated: November 15, 2010

By: Walter G. Hanchuk/  
Walter G. Hanchuk  
Registration No.: 35,179

Correspondence Address:

CHADBOURNE & PARKE LLP  
30 Rockefeller Plaza  
New York, NY 10112

212-408-5100 (Telephone)  
212-541-5369 (Facsimile)  
patents@chadbourne.com (E-mail)